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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,345	11/07/2001	Hiroyuki Makino	U 013708-5	8959
140	7590	04/07/2004	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			JACKSON, SUZETTE JAMIE	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,345

Applicant(s)

MAKINO, HIROYUKI

Examiner

Jackson J Suzette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,9,10,12-14,16,18 and 20 is/are rejected.
- 7) ☒ Claim(s) 3-6,8,11,15,17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/7/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 12 recites the limitation "distal end parts". There is insufficient antecedent basis for this limitation in the claim.
4. Claim 18 recites the limitation "probe tube segments". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1-2, 14, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurihashi 6,383,192. Kurihashi discloses the invention as claimed comprising: A nasolacrimal stent/tube; with a flexible detention tube (42) wherein the tube is provided with at least one opening (49) formed in a part thereof at a predetermined distance from one of opposite ends thereof; wherein the distal end parts of the flexible tube are tapered and have rounded tips (53); wherein the opening of the flexible tube is formed in an outer corner (*51 constitutes the corner and 49 is on the outer corner*) of a bend formed by bending a part of the flexible tube at an angle to the other part of the same; and tube position finding means (61) capable of being inserted in and being extracted from the flexible tube opening.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurihashi in view of O'Donnell, Jr. 5,345,948. Kurihashi has been disclosed above however Kurihashi does not specify the use of a fiber optic illuminating element. O'Donnell Jr. teach a type of surgery performed through the canaliculus and lacrimal sac that utilizes a fiber optic bundle which is passed through the punctum. It would have been obvious to one having ordinary skill in the art

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at the time the invention was made to take the invention of Kurihashi and utilize the fiber optic utilized by O'Donnell Jr. by passing it through opening (49) because it would provide visualization for the surgeon to assure proper placement of the device.

9. Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurihashi in view of Shantha 5,792,100. Kurihashi has been disclosed above however does not specify a bougie. Shantha discloses a nasal sinus surgery that utilizes a bougie. It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the opening (49) of Kurihashi and utilize a bougie as taught by Shantha because the bougie could further act in guiding the tube into the proper passageway.

Allowable Subject Matter

10. Claims 3-6, 8, 11, 15, 17, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 12 and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mendius et al. 6,605,108 ; Walsh et al. 6,547,765 ; Walsh 6,117,116 ; Kurihashi 5,437,625 ; and Ector, Jr. 4,658,816 all show related material.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 703-308-6516.

14. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Suzette J. Jackson
31 March 2004